

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Roy et al.)	
) Art Unit:	1794
)	
Serial Number) Examiner:	Stulii, Vera
)	
Filed) Atty Docket:	6357US
For: Dry Mix Compositions and Method for Making and Utilizing the Same Having an Enhanced Anti-Microbial Shelf Life		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

**Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450**

Sir:

Applicant hereby request a Pre-Appeal Brief Review of the Final Office Action issued November 28, 2008 in the above-identified U.S. patent application based at least on the Examiner making the following clear errors:

- 1) the Examiner has failed to provide any prior art either singly or in combination which teach a mean particle size of about 150 microns – 840 microns as claimed;
- 2) the Examiner has failed to provide any prior art which when taken singly or in combination discloses or renders obvious a minimum melting point of 150°F as set forth in the claims and explained more fully below; and
- 3) the Examiner has not addressed each limitation of independent claim 35.

Initially, it should be noted that each of independent claims 1, 19, 37 and 58 of the present application require an encapsulated acid having a mean particle size of about 150-840 microns. The Examiner admits that Narayanaswamy et al. does not teach a mean particle size of about 150-840 microns as claimed. The Examiner then turns to Navarro which teaches coated fumaric acid having a particle size from about 70 to 140

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microns. This particle size is outside of the claimed range. Additionally, the coated fumaric acid particles of Navarro preferably have a coating melting point of above 125°F. In contrast, the present invention requires a **minimum** melting point of 150°F as set forth in claims 18, 24, 57 and 62. As none of the prior art teaches the minimum melting point as claimed or the particle size as claimed, no proper prima facie case of obviousness has been established for claims 1, 6-19, 23-34, 37 and 57-62.

Particle Size

Apparently, the Examiner is of the opinion that since various independent claims in the present application recite a range of “about 150 microns to about 840 microns” and Navarro discloses a particle size from about 70 microns to about 140 microns, the word “about” allows for a size slightly above 140 microns and slightly below 150 microns such that the ranges overlap. While the Applicant does agree that the word “about” is not claiming an exact number but rather some type of variation from the end points of the range, Applicant respectfully submits that the Examiner is expanding the word “about” from its intended meaning. The courts have already ruled that “about” is not an arbitrary term but rather a flexible word with a meaning similar to “approximately” or “nearly.” See *Ex parte* Eastwood, 163 USPQ 316, 317 (Pat. Off. Bd. App. 1968). The courts have held that the term “about” must be determined based on the facts of the case, particularly the prior art verses invention disclosures. Navarro teaches particle size from about 70 to 140 microns, i.e., a 70 micron range, as well as a preferred size of 105 microns. It would be unreasonable to assume that either the 70 micron value or 140 micron value could be expanded an additional 10 or more microns (approximately 15% for the 70 microns and 7% for the 140 microns) based on the word “about.” In fact, the Examiner’s attention is additionally drawn to the Federal Circuit case of *Eiselstein v. Frank*, 52 F.3d 1035, 34 USPQ 2d 1467, 1468, 1471 (Fed. Cir. 1995) wherein claims reciting a nickel based alloy containing “the balance nickel with nickel constituting about 50 to about 60% of the alloy” were held not to include a nickel range of 45-55%. With this in mind, Applicant respectfully submits that the use of the word “about” clearly does not correlate the upper end of 140 microns in Navarro overlapping with the lower end of 150 microns as

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presently claimed. In other words, a range of 70-140 microns is not “about” a range of 150-840 microns.

In regards to the Examiner’s second argument (newly made, but not necessitated by any claim amendments, in the Final Rejection) that one of ordinary skill in the art would have been motivated to modify particle size of the capsule depending on a desired thickness of the particle coating and the amount of substance contained therein, it would appear that the Examiner has actually provided no support for this type of motivation. Indeed, close review of Navarro makes clear that tortilla dough made with a large sized, i.e., mean particle size of 300 microns, encapsulated fumaric acid particulates was deemed particularly undesirable. The Examiner’s attention is drawn to Figure 1 of the Navarro patent clearly showing that line 8 provides for a much too low pH content. Note that the acid dissolution profile is important because the tortilla is pressed into shape at approximately 30 minutes and it is important for the dough to remain neutral at this time so that the pressed tortilla does not retract into a smaller shape. See the discussion in column 7, line 34 through column 7, line 60. Indeed, the only line that yields a desired dissolution profile is line 2 corresponding with the preferred mean particle size of about 105 microns. See column 5, lines 30-35 and column 7, lines 27-29. In view of the test results set forth in Navarro explicitly stating that adding larger sized encapsulated fumaric acid particles is considered highly undesirable, it is unclear why the Examiner would consider it obvious to increase the particle sizes of Navarro significantly beyond the high end of 140 microns. Indeed, in view of Navarro’s explicit statement that the mean particle size coated dispersed fumaric acid particulate should be set at about 70-140 microns, preferably about 80-130 microns, more preferably about 90-120 microns, and most preferably 105 microns (see column 3, lines 50-56), presumably it would be obvious to one of ordinary skill in the art to use a fumaric acid particulate size no greater than 140 microns and actually closer to 105 microns as that is the explicit teaching in column 3, lines 50-60. Any other size would be quite contrary to the teaching of the Navarro reference. Given that: 1) Navarro teaches that it is most preferable to use a mean particulate size of 105 microns, 2) Navarro specifically discloses that using large

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sized particulates is particularly bad, 3) the present application has a low end particle size that is higher than the high end particle size in Navarro, and 4) the present application specifically states that “The large particulate size surprisingly is beneficial in producing the appropriate release rate of the particulate in the present invention” (see paragraph 0049), it is surprising to the Applicant that the Examiner would somehow come to the conclusion that either Navarro meets the claimed 150-840 micron range or the range would be obvious in the proposed combination. Therefore, Applicant respectfully submits that this rejection should be withdrawn.

Melting Point

In regards to the melting point of 150°F as set forth in the claims, the Examiner argues that Navarro actually teaches a range above 125°F as a melting point and thus encompasses the 150° claimed. Apparently, there has been a complete miscommunication between the Applicant and the Examiner. The Applicant has claimed a minimum melting point of 150°F. A melting point of 125°F is clearly below the minimum of 150°F and therefore does not anticipate or render obvious the minimum of 150°F. Even a melting point between 125° and 150°F would not be a minimum of 150°F. The Examiner is reminded that the claims do not claim a melting point of 150°F, but rather a minimum melting point of 150°F. This limitation is simply not met by the applied prior art or properly addressed in the final Office Action.

Claim 35

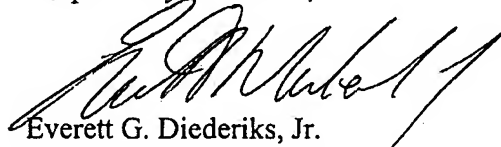
In regards to claim 35, it would appear that the Examiner is using Narayanaswamy et al. as a base reference. The Examiner’s position is apparently that Applicant’s argument is attacking the references individually. Certainly, the statement “neither Narayanaswamy et al. nor Navarro teaches the step of deep frying batter and oil to produce a batter product having an internal cook temperature of 170°F as required by claim 35” was intended to address the references both individually and in combination. However, for clarity the Applicant wishes to restate this point. However, neither Narayanaswamy et al. nor Navarro teaches the step of deep frying batter in oil to produce

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a fried bakery product having an internal cook temperature of about 170°F to about 230°F as required by claim 35. Therefore, it does not matter how these references are combined since neither reference has this feature. In fact, it must be realized that Narayanaswamy is concerned with a shelf stable batter, while Navarro is concerned with prolonging the shelf life of an already baked product. To this end, the Applicant would submit that one of ordinary skill in the art would not even look to an invention concerned with preserving an already baked product (Navarro) to modify a batter intended to be placed on a store shelf and used to make a baked product which would be presumably, immediately consumed by a consumer (Narayanaswamy).

Based at least the points raised above, it should be clear that the applied combination cannot possibly meet these claim limitations. If the Examiner would like to further discuss the application, the Examiner is cordially invited to contact the undersigned at the number provided below.

Respectfully submitted,



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